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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,335	12/22/1998	KYOJI OMI	0557-4442-2R	3249

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 05/27/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/218,335

Applicant(s)

OMI, KYOJI

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 48 and 49 is/are allowed.
- 6) ☒ Claim(s) 12-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

JEROME GRANT II  
PRIMARY EXAMINER

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**Final Rejection**

1. Claims 12-47 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.
2. In this Reissue Application, the decision from *Pannu v. Storz Instruments* (Fed. Cir. 2001) is being applied.

The court explained:

“The recapture rule ‘prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.’ **Clement**, 131 F.3d at 1468 USPQ2d at 1164. Reissue claims that are broader than the original patent’s claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. **Mentor Corp. V. Coloplast**, Inc 998 F.2d 992, 995, 27 USPQ 2d 1521, 1524 Fed. Cir. 1993). Application of the recapture rule is a three-step process. The first step is to ‘determine whether

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and in what *aspect* the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; Clement, 131 F.3d at 1470, 45 USPQ 2d 1165.”

Moreover, this court restated: A REISSUE CLAIM THAT DOES NOT INCLUDE A LIMITATION PRESENT IN THE ORIGINAL PATENT CLAIM IS BROADER IN THAT RESPECT. Hester, Id.

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3. Based upon the ruling established in Pannu, the examiner will apply the ruling to the instant case.

### **FIRST STEP ANALYSIS**

The first inquiry is to determine whether and in what aspect the Reissue claims are broader than the patent claims. Upon examination, it is determined that the Reissue claims are broader. The aspect of determining the broadening of the Reissue claim is that neither claims 12 and 30 recite:

- a) second I/O;
- b) no image and control data;
- c) no system control module;
- d) no 3rd I/O
- e) no system control means

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## SECOND STEP ANALYSIS

The second inquiry is to determine whether the broader aspects of the Reissued claim related to surrendered subject matter. (Note that the Hester decision, *Id.* stated in part: A reissue claim that does not include a limitation present in the original patent claim is broader in that respect). Upon further consideration, in the parent application, 08/215,608, upon which the REISSUE application is based, applicant filed an amendment received in the Patent Office on June 17, 1996. This amendment, among other things, adds limitations a) - e) which were identified in the FIRST STEP ANALYSIS above. The June 17, 1996 amendment placed the application in condition for allowance. Hence, applicant surrendered limitations a) - e) in order to obtain the patent which issued as U.S. Pat. 5,60,0445.

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### **THIRD STEP ANALYSIS**

The second inquiry is whether the REISSUED claims were materially narrowed in other respects to avoid the recapture rule. The examiner submits that the claims were narrowed in other respects. The REISSUE claims 12 and 30 were narrowed in that the first and second modules include at least a power input means for supplying power to the scanner and printer. This limitation is thought to be narrowed for the reason that the limitation did not appear in claims 1-11 of the parent case of the instant REISSUE Application.

### **CONCLUSION**

The examiner therefore, contends that based upon the three step analysis provided by *Pannu*, claims 12-47 are properly rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue was based.

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**Allowed Claims**

4. Claims 1-11, 48 and 49 are allowed.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to :00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

J. Grant II

  
JEROME GRANT II  
PRIMARY EXAMINER